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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,333	04/01/2004	Gregory Plos	05725.1306-00000	5339

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EXAMINER	
ELHILO, EISA B	

ART UNIT	PAPER NUMBER
1751	

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/814,333	PLOS ET AL.	
	Examiner	Art Unit	
	Eisa B. Elhilo	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/17/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claims 1-28 are pending in this application.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,8,9,26 and 27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 34, 36-37, 46-48 of copending Application No. 10/814,300, over claims 44, 46-47, 49 of the copending Application No. 10/814,305, over claims 41, 43-44, 46 of the copending Application No. 10/814,430, over claims 35, 37-38, 40, 42 of the copending Application No. 10/814, 334, over claims 1 and 24 of the copending Application No. 10/814,338, over claims 36, 40-41, 43, 55, 56 of the copending Application No. 10/814,236, over claims 47,49-50,54 of the copending Application No. 10/814,585, over claims 39, 41-44, 47 of the copending Application No. 10/814,337, over claims 1, 44,46, 47 of the copending Application No. 10/742,995, over claims 1-3 of the copending Application No. 10/814,336, over claims 47-49, 64-65 of the copending Application No. 10/814,428, over claims 32,36-39 of the copending Application No. 10/814,335 and over claims 39, 44,49 of the copending Application No. 10/490,869. Although the conflicting claims are not

identical, they are not patentably distinct from each other because the claims of the copending Applications No.10/814,300, 10/814,305, 10/814,430, 10/814,334, 10/814,338, 10/814,236, 10/814,585, 10/814,337, 10/742,995, 10/814,336, 10/814,428, 10/814, 335 and 10/490,869 teach and disclose similar dyeing processes for dyeing hair comprising applying to the hair dyeing compositions comprising similar fluorescent compounds that are soluble in the cosmetically acceptable medium as claimed. Therefore, this is an obvious formulation.

Although, the claims of the copending Applications No. 10/814,300, 10/814,305, 10/814,430, 10/814,334, 10/814,338, 10/814,236, 10/814,585, 10/814,337, 10/742,995, 10/814,336, 10/814,428, 10/814, 335 and 10/490,869 teach and disclose similar hair dyeing formulation, they are not identical to the instant claims, because the claims of the copending Application No. 10/814,300, 10/814,305, 10/814,430, 10/814,334, 10/814,338, 10/814,236, 10/814,585, 10/814,337, 10/742,995, 10/814,336, 10/814,428, 10/814, 335 and 10/490,869 require other dyeing ingredients to be presented in the dyeing compositions that applied to the hair, while the instant claims do not require any other dyeing ingredients beside the fluorescent dye in the composition that applied by the instant process. Therefore, the conflicting claims are not identical.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply such a dyeing process to arrive at the claimed composition because the claims of the copending Applications clearly teach processes for dyeing hair comprising the claimed fluorescent dye as described above, and thus, an ordinary artisan would have been motivated to apply to the hair and a dyeing composition comprising the claimed

fluorescent and would expect such a process to have similar results to those claimed, absent unexpected results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

2 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

3 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6 and 10-20 are rejected under 35 U.S.C. 102(a) as being anticipated by or, in alternative, under 103(a) as obvious over Matsunaga et al. (US 2001/0054206 A1).

Matsunaga et al. (US' 206 A1) teaches a method for dyeing hair comprising applying to the hair a dyeing composition (see page 3, paragraph, 0026), wherein the composition comprises a fluorescent methine compound of a formula (2), wherein the reference's formula (2), is identical to the claimed formula (F3) as claimed in claims 1 and 5-6 (see page 1, paragraph, 0008), wherein the fluorescent compound is presented in the dyeing composition in the amounts of 0.01 to 20%, 0.05 to 10% or 0.1 to 5% as claimed in claims 10-12 (see pages 2-3, paragraph,

0016), wherein the composition further comprises at least one surfactant as claimed in claim 17 (see page 3, paragraph, 0025), wherein the surfactant presented in the amount of 3.5% which within the claimed range as claimed in claim 18 (see page 5, Example 13), additional direct dyes of nitro dyes as claimed in claim 19-20 (see page 3, paragraph, 0023), oxidizing agents of hydrogen peroxide, perborates and laccase enzyme (four-electron oxidreductase) as claimed in claims 70-74 (see page 3, paragraphs, 0018 and 0019), wherein the composition is prepared into a two-part composition as claimed in claims 93-94 (see page 3, paragraph, 0026). Matsunaga et al. (US' 206 A1) teaches the same dyeing ingredients of fluorescent azomethine in the claimed amounts, which inherently would have the same physical properties of reflectances, colors and solubility as claimed in claims 2-4 and 13-16. Matsunaga et al. (US' 206 A1) teaches all the limitations of the instant claims and, hence the claims are anticipated by Matsunaga et al. (US' 206 A1) .

However, the claims in the alternative, under 35 U.S.C. 103(a) are obvious over Matsunaga et al. (US' 206 A1), because the reference teaches a hair dyeing composition comprising the same claimed dyeing ingredients of azomethine compound in the claimed amounts wherein the chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. (see *In re Spada, 911 F. 2d 705, 709, 15 USPQ2d 1655, 1658* (Fed. Cir. 1990), and, thus, a person of the ordinary skill in the art would expect such a dyeing composition to have ingredients having similar physical properties as those claimed including solubility and reflectance of light as claimed. Absent unexpected results.

4 Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsunaga et al. (US 2001/0054206 A1) in view of Rondeau (US 6,436,153 B2).

The disclosures of Matsunaga et al. (US' 206 A1) as described above, does not teach or disclose the fluorescent compound of the claimed formula (F1) in which X- is an anion chosen from the claimed radicals.

However, Matsunaga et al. (US' 206 A1) suggests that other direct (fluorescent) dyes may be used in the dyeing composition (see page 2, paragraphs, 0014 and 0015).

Rondeau (US' 153 B2) in analogous art of hair dyeing formulation, teaches a composition comprising a fluorescent dye having a formula similar to the claimed formula (F1), (see col. 7, formula 14).

Therefore, in view of the teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be motivated to modify the composition of Matsunaga (US' 206 A1) by incorporating the fluorescent dyes as taught by Rondeau (US' 153 B2) to make such a composition. Such a modification would be obvious because the primary reference of Matsunaga et al. (US' 206 A1) suggests the use of fluorescent dyes in the dyeing composition (see page 2, paragraph, 0014). Rondeau (US' 153 B2) as a secondary reference clearly teaches and discloses the fluorescent compound of the claimed species, and, thus, a person of the ordinary skill in the art would be motivated to incorporate the fluorescent compound of the claimed species as taught by Rondeau (US' 153 B2) in the dyeing composition of Matsunaga (US' 206 A1) with a reasonable expectation of success for improving the dyeing properties of the composition and would expect such a composition to have similar properties to those claimed, absent unexpected results.

5 Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsunaga et al. (US 2001/0054206 A1) in view of Vandenbossche et al. (US 6,391,062 B1).

The disclosure of Matsunaga (US' 206 A1) as described above, does not teach or disclose direct dyes in the claimed amounts. However, the reference generally suggests the use of direct dyes in the keratin fiber formulation (see page 2, paragraph, 0015 and page 3, paragraph, 0023).

Vandenbossche et al. (US' 062 B1) in other analogous art of keratin fibers dyeing formulation, teaches a dyeing composition comprising direct dyes such as nitrobenzene and anthraquinone dyes in the amounts of 0.5 to 10% which overlapped with the claimed ranges as claimed in claims 21-22 (see col. 7, lines 62-67 and col. 8, lines 1-3).

Therefore, in view of the teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be motivated to modify the composition of Matsunaga (US' 206 A1) by incorporating the direct dyes in the claimed amounts as taught by Vandenbossche et al. (US' 062 B1) to make such a composition. Such a modification would be obvious because the primary reference suggest the use of direct dyes in the dyeing composition (see page 2, paragraph, 0015). Vandenbossche et al. (US' 062 B1) as a secondary reference clearly teaches and discloses direct dyes of the claimed species nitrobenzene and anthraquinone dyes to broaden the range of shades and to obtain varied shades (see col. 7, lines 59-65), and, thus, a person of the ordinary skill in the art would be motivated to incorporate the direct dyes as taught by Vandenbossche et al. (US' 062 B1) in the dyeing composition of Matsunaga (US' 206 A1) with a reasonable expectation of success for obtaining varied shades and would expect such a composition to have similar properties to those claimed, absent unexpected results.

6 Claims 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsunaga et al. (US 2001/0054206 A1) in view of Giuseppe et al. (US' 5,744,127).

The disclosure of Matsunaga (US' 206 A1) as described above, does not teach or disclose a composition in the form of a dyeing shampoo.

However, Matsunaga et al. (US' 206 A1), teaches that no particular limitation is imposed on the form of the hair dyeing composition (see page 3, paragraph, 0027).

Giuseppe et al. (US' 127) in other analogous art of hair treating formulation, teaches compositions formulated as a hair shampoo and hair dyeing as well (see col. 6, lines 5-6).

Therefore, in view of the teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be modified to formulate the dyeing composition of Matsunaga et al. in a shampoo form at taught by Giuseppe et al. to arrive at the claimed composition. Such a modification would be obvious because Giuseppe et al. clearly teaches that the dyeing composition can be formulated in a shampoo form, and, thus, one having ordinary skill in the art would be motivated to formulate the dyeing composition in any form includes the shampoo form, and would expect such a composition to have similar properties to those claimed, absent unexpected results.

7 Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsunaga et al. (US 2001/0054206 A1) in view of Wenke (US 5,316,551).

The disclosures of Matsunaga et al. (US' 206 A1) as described above, does not teach or disclose the step of applying to the keratin fibers at least one alkaline aqueous composition with a pH of at least 10 before applying the dyeing composition.

Wenke (US' 5,316,551) in analogous art of hair dyeing formulation, teaches a process for dyeing hair comprising the step of applying to the hair a pretreatment solution comprising sodium hydroxide and wherein the solution has a pH in the range of 6 to 10 (see col. 5, lines 50-54) and wherein the pretreatment solution is retained in contact with the hair for a sufficient time before rinsing the hair as claimed in claim 24 (see col. 5, lines 12-16).

Therefore, in view of teaching of the secondary reference one having ordinary skill in the art at the time the invention was made would be motivated to modify the process of dyeing hair of Matsunaga et al. (US' 206 A1) by applying to the hair the an alkaline composition as a pretreatment step before dyeing the hair as taught by Wenke (US' 551) to arrive at the claimed invention with a reasonable expectation of success for improving the coloring effect on hair and would expect such a process to have similar properties and similar results to those claimed, absent unexpected results.

8 Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsunaga et al. (US 2001/0054206 A1) in view of Jacquet et al. (US 4,517,174).

The disclosures of Matsunaga et al. (US' 206 A1) as described above, does not teach or disclose the step of applying to the keratin fibers a reducing composition followed by application of an oxidizing composition as claimed.

Jacquet et al. (US' 174) in analogous art of hair dyeing formulation, teaches a process comprising the step of applying to the hair a reducing composition followed by application of an oxidizing composition as claimed (see col. 12, lines 5-15).

Therefore, in view of teaching of the secondary reference one having ordinary skill in the art at the time the invention was made would be motivated to modify the process of dyeing hair

of Matsunaga et al. (US' 206 A1) by applying to the hair the steps of reducing and oxidizing compositions as taught by Jacquet et al. (US' 174) to arrive at the claimed invention. Further, it is taught by Jacquet (US' 174) that the process is applied to the hair particularly before, or after dyeing (see col. 14, lines 18-21) and, thus, a person of the ordinary skill in the art would be motivated to utilize such a process for treating hair, and would expect such a process to have similar properties to those claimed, absent unexpected results.

9 Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsunaga et al. (US 2001/0054206 A1).

The disclosure of Matsunaga et al. (US' 206 A1) as described above, does not teach or disclose the type of hair that has been dyed.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply such a dying composition to any human keratin materials as claimed because the disclosure of the reference clearly teach the claimed dyeing ingredient (fluorescent of azomethine compound) in the claimed amounts, which should have similar properties and could applied to similar human keratin materials, and, thus, a person of the ordinary skill in the art would expect such a composition be used or applied to any keratin fibers including the artificially dyed or pigmented keratin fibers as claimed and with different tone heights including the claimed tone, and would expect such a composition that applied by similar process to have properties and effects similar to those claimed, absent unexpected results.

Conclusion

10 The remaining references listed on from 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B. Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Eisa Elhilo
Primary Examiner
Art Unit 1751

May 15, 2006